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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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EXAMINER

BRASE, SANDRA L

ART UNIT PAPER NUMBER

2852

DATE MAILED: 04/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/733,421

Applicant(s)

HAINES, ROBERT E.

Examiner

Sandra L. Brase

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 24-28, 30-35, 37-40, 42, 43 and 45-48 are rejected under 35 U.S.C. 102(b) as being anticipated by Tarr et al. (US 5,184,179).

Tarr et al. (...179) disclose a system and method comprising: detecting status information relating to a hard copy output engine using sensors coupled to the engine, including status of a future need for maintenance (col. 6, lines 3-9) and billing information for job accounting (col. 5, lines 14-59); composing an electronic message including the detected status (col. 5, lines 37-59; and col. 6, lines 3-26); and transmitting the electronic message to a scheduling engine (col. 5, lines 37-59 and col. 6, lines 3-26). The detecting includes detecting a toner low or toner out status; a low paper or out of paper status; and a low consumables or out of consumables status, where the amount remaining of all engine consumables are detected (col. 5, line 60 – col. 6, line 2). Furthermore, detecting a status includes: preventative maintenance alerts (col. 6, lines 20-23), replacement of a component part (col. 7, lines 61- col. 8, line 55); billing information (col. 5, lines 14-30); internal and external billing dates for job accounting (col. 5, lines 14-30 and col. 6, lines 27-38); and need maintenance (col. 6, lines 3-23). The hard output engine can be a facsimile machine, a photocopier or a printer (col. 18, lines 30-36). The

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electronic message can include a percentage of remaining consumable (col. 5, line 60 – col. 6, line 2); duration (col. 7, line 61 – col. 8, line 55); expected completion date (col. 8, lines 33-46); due date (col. 6, lines 20-23); expiration date (col. 6, lines 3-9); resources (col. 5, line 60 – col. 6, line 2; and col. 7, line 61 – col. 8, line 55); start date (col. 8, lines 33-46); tracking status (col. 8, lines 7-12); maintenance items (col. 8, lines 33-46); malfunction (col. 9, lines 47-54); and preventative maintenance items (col. 5, line 67 – col. 6, line 9).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 29, 36 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tarr et al. (US 5,184,179) in view of Ohtani (US 6,108,099).

Tarr et al. (...179) disclose the features mentioned previously, but do not disclose the electronic message including a consumable order. Ohtani (...099) discloses an electronic message including a consumable order (col. 6, lines 10-36 and col. 7, lines 1-47). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the electronic message include a consumable order so that a user can order items to replace those that were consumed, as disclosed by Ohtani (...099).

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5. Claim 44 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tarr et al. (US 5,184,179) in view of Ohtani (US 6,108,099), Brouwer et al. (US 5,841,982), Goodale et al. (US 5,125,075), Goodhand et al. (US 5,923,848), Scully et al. (US 4,819,191), Nolte (US 6,434,571) and Brunson (US 5,647,002).

Tarr et al. (...179) disclose the features mentioned previously, but do not disclose detecting consumable orders, and the electronic message including all of the claimed elements, where Tarr et al. (...179) further disclose the electronic message including calendar events (col. 6, lines 20-23). Ohtani (...099) discloses detecting a need for a consumable order and an electronic message including the consumable order (col. 5, line 35 – col. 6, line 36; and col. 7, line 1-47). The electronic message also includes the information: company addressed to (col. 6, lines 10-20; col. 6, lines 51-60; and col. 7, lines 18-29); event address (col. 5, lines 35-49); owner (col. 6, lines 10-20; col. 6, lines 51-60; and col. 7, lines 18-29); date sent (col. 6, lines 10-20; col. 6, lines 51-60; and col. 7, lines 18-29); and addressee (col. 6, lines 10-20; col. 6, lines 51-60; and col. 7, lines 18-29). It would have been obvious to one of ordinary skill in the art at the time the invention was made to detect a need for a consumable order and an electronic message including the consumable order so that a user can order items to replace those that were consumed, as disclosed by Ohtani (...099); and it would have also been obvious for the electronic message to include the company addressed to, event address, owner, date sent, and addressee, since it is well known for an electronic message to include such information, as disclosed by Ohtani (...099). Brouwer et al. (...982) disclose an electronic message including blind copy to, copy to, priority and return receipt status (col. 2, lines 25-27). It would have been obvious to one of ordinary skill in the art at the time the invention was made for the electronic

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message to include blind copy to, copy to, priority and return receipt status, since it is well known for an electronic message to include such information, as disclosed by Brouwer et al. (...982). Goodale et al. (...075) disclose an electronic message that includes the information relating to defer until (col. 1, lines 34-39). It would have been obvious to one of ordinary skill in the art at the time the invention was made for the electronic message to contain information relating to defer until since such information improves the efficiency of the electronic message, as disclosed by Goodale et al. (...075). Goodhand et al. (...848) disclose an electronic message including a follow-up flag (col. 23, lines 25-30), remind beforehand (col. 25, line 64 – col. 26, line 34; and figure 18), reminder (col. 25, line 64 – col. 26, line 34; and figure 18) and reminder override default (col. 25, line 64 – col. 26, line 34; and figure 18). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the electronic message include information relating to a follow-up flag, remind beforehand, reminder and reminder override default, since it is well known in the art to include such in an electronic message, as disclosed by Goodhand et al. (...848). Scully et al. (...191) disclose the electronic message including information relating to importance (col. 24, lines 47-53). It would have been obvious to one of ordinary skill at the time the invention was made for the electronic message to include information relating to importance, since it is well known in the art to include such in an electronic message, as disclosed by Scully et al. (...191). Nolte (...571) discloses an electronic message including information relating to required attendee list (col. 2, lines 44-55). It would have been obvious to one of ordinary skill in the art at the time the invention was made for the electronic message to include information relating to required attendee list since it is well known in the art to include such in an electronic message, as disclosed by Nolte (...571). Brunson

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(...002) discloses an electronic message including information relating to sensitivity (col. 15, lines 13-16). It would have been obvious to one of ordinary skill in the art at the time the invention was made for the electronic message to include information relating to sensitivity, since it is well known in the art to include such in an electronic message, as disclosed by Brunson (...002).

Response to Arguments

6. Applicant's arguments filed 12/27/02 have been fully considered but they are not persuasive.

Applicant argues that Tarr et al. (US 5,184,179) do not disclose a sensor; however, this is incorrect, as explained above Tarr et al. (...179) disclose a detector (18) that is a sensor that detects a status of the hard copy engine, where a count is used to indicate a plurality of statuses of the hard copy engine.

7. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, there is motivation to combine Tarr et al. (US 5,184,179) with Ohtani (US 6,108,099) so that a user can easily order items to replace those that were consumed.

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8. In response to applicant's argument that the examiner has combined an excessive number of references, reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

9. In response to applicant's argument that Brouwer et al. (US 5,841,982), Goodale et al. (US 5,125,075), Goodhand et al. (US 5,923,848), Scully et al. (US 4,819,191), Nolte (US 6,434,571) and Brunson (US 5,647,002), is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, all of the references relate to electronic messaging, which is in the same field as applicant's endeavor.

Final Rejection

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contacts \ Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra L. Brase whose telephone number is (703) 308-3101.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Arthur T. Grimley, can be reached on (703) 308-1373. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3431 or 305-3432.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



Sandra L. Brase
Primary Examiner
Art Unit 2852

April 1, 2003